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EXAMINER
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HOFFMAN, SUSAN COE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/006,389  
Filing Date: December 10, 2001  
Appellant(s): THOREL, JEAN-NOEL

**MAILED**  
**SEP 20 2007**  
**GROUP 1600**

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William P. Berridge  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 25, 2007 appealing from the Office action mailed September 8, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3, 5-13, 16, 18-23 and 29. The brief states that claims 9-11, 13, 21, and 22 have been cancelled. However, these claims have *not* been cancelled.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

5,508,034	BERNSTEIN	4-1996
5,886,041	YU	3-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-8, 12, 16, 18-20, 23, and 29 stand rejected under 35 U.S.C. 102(b) as being anticipated by Bernstein (US Pat. No. 5,508,034).

This reference teaches a composition for treating the skin. The composition comprises three classes of lipids naturally found in the stratum corneum layer of the skin (see column 1, line 49 - column 2, line 18 and claims). The composition can be applied with only the skin lipids, a vehicle is not required (see abstract). The composition as claimed in claims 1 and 7 also does not require a vehicle and contains only skin lipids.

Claims 1, 9-11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (US Pat. No. 5,508,034).

The teachings of Bernstein are discussed above. The reference does not specifically teach using a two phase oil-in-water or water-in-oil form. However, these are well known forms for cosmetic compositions. Thus, a person of ordinary skill in the art would reasonably expect that the composition of Bernstein can take those forms. This reasonable expectation of success would motivate the artisan to modify the composition of Bernstein to include these two phase forms.

The reference does teach using a "minor" water in the composition. Appellant has defined a "minor" amount of water as being any amount of water under 50% in the composition.

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The reference does not teach using water in amounts around 50% (see examples). The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of the appellant's invention.

Claims 1, 9-11, 16, 21, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein (US Pat. No. 5,508,034) in view of Yu (US Pat. No. 5,886,041).

As discussed above, Bernstein teaches a composition that is considered to anticipate the appellant's composition as claimed in claim 1. The reference teaches using skin ingredients to make a composition for treating dry skin. The reference does not specifically teach using trace elements or amino acids in this composition. Yu teaches a composition for treating dry skin that contains amino acids and trace elements (see column 3, lines 39-46). The reference also teaches oil-in-water forms for the composition (see Examples). As discussed in MPEP 2144.06:

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.

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Thus, it would have been obvious at the time of invention to include amino acids and trace elements in the cosmetic composition taught by Bernstein.

The references also do not specifically teach adding the ingredients in the amounts claimed by the appellant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of the appellant's invention.

#### **(10) Response to Argument**

Please note that on February 7, 2007 the appellant submitted a Request for Reconsideration in response to the non-final rejection of September 8, 2006. Prior to a response from the examiner, the appellant then filed a Notice of Appeal and an Appeal Brief. The arguments presented in the response of February 7, 2007 and the arguments presented in the Appeal Brief are duplicative of each other. Thus, in the responding to the arguments in the Appeal Brief, the arguments in the response of February 7 have also been considered and answered herein.

In response to the 102(b) rejection over Bernstein, the appellant argues that Bernstein does not teach a composition that comprises a biodermal fraction representing 98-100% by weight. The appellant argues that Bernstein teaches a product that is different from the claimed subject matter because the claimed composition “cannot be classified or distributed between an active fraction...and an inactive fraction.” The appellant argues that Bernstein’s products require 38% to 40% by weight of non-biodermal constituent as set forth in Examples 1 and 2 and Formulas 1-3; thus, the product of the reference only contains 60-62% of a biodermal fraction rather than 98-100% of a biodermal fraction as claimed by the appellant. The appellant argues that this range as taught by Bernstein does not overlap the range claimed by the appellant with “sufficient specificity” for anticipation as required in MPEP section 2131.03.

However, the examiner does not consider these arguments persuasive. In pointing out only Examples 1 and 2 and Formulas 1-3, the appellant is not considering all of the teachings of the reference. The Examples and Formulations are embodiments of the claimed invention but are not embodiments that are claimed. The embodiments are not the only teaching set forth in the reference as these embodiments were not stated by the examiner as anticipatory of the appellant’s claimed invention. The claims of Bernstein *do* anticipate the appellant’s claimed invention. Claim 1 in the reference recites a method for treating dry skin using a concentrate comprising *only* ingredients found in the stratum corneum layer of the skin. Claim 7 is directed to the cosmetic concentrate itself. The concentrate is claimed as have *only* three ingredients. The first ingredient, ingredient (a), in claims 1 and 7 is specifically claimed as “a mixture of *naturally* occurring stratum corneum free fatty acids or triglyceride forms of said fatty acids mixture in a proportion of about 25% to about 75% by weight...” (emphasis added). Ingredient

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(b) is specifically claimed as “a mixture of *naturally* occurring stratum corneum cholesterol or esters of said cholesterol in a proportion of about 10% to about 40% by weight...”(emphasis added). Ingredient (c) is specifically claimed as “one or more *naturally* occurring stratum corneum lipids selected from the group consisting of ceramide, lecithin, and cephalin in a proportion of about 5% to about 40% by weight...”(emphasis added). Thus, claim 1 claims a method of treating the skin using a concentrate and claim 7 claims the concentrate itself. The concentrate is claimed as having three ingredients naturally found in the skin. Thus, these ingredients are biodermal constituents as claimed by the appellant because they are constituents of the dermis. The claims specifically claim including amounts of these ingredients that result in a composition that contains 100% of ingredients naturally found in the skin. No other ingredients are recited in the claims. Thus, the claims properly anticipate applicant’s claim 1 because the reference claims a cosmetic composition that comprises 100% of a biodermal fraction. This claimed composition is set forth with sufficient specificity to properly anticipate the appellant’s claimed composition as discussed in MPEP section 2131.03. The appellant’s discussion of the Examples and the Formulations set forth in the reference fails to take into account what is specifically claimed by the reference.

In regards to the 103(a) rejection based on Bernstein, the appellant argues that Bernstein teaches mixing the active lipid concentrate with water; thus, water is a component of the excipient and not a biodermal fraction as recited in claim 1. The appellant argues that even if Bernstein did teach water as part of the active biodermal fraction, the Office has failed to demonstrate that a skilled artisan would be motivated to vary the therapeutic formulation of Bernstein. The appellant argues that the assertion of the Office action are based on improper



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hindsight reasoning. The appellant argues that improper hindsight is used because Bernstein does not teach any formulations that contain less than 50% water by weight. The appellant argues that an artisan of ordinary skill would not be motivated to use less than 50% water by weight because the reference does not demonstrate that water is a result effective variable.

However, these arguments are not considered persuasive. Bernstein does teach that water can be used to dilute the skin lipid concentrates taught in the invention. Bernstein does not specifically teach that the water is extracted from skin. However, water *is* naturally found in the skin. This is a well known fact and is admitted by the appellant in the specification on page 8, lines 15-19. Thus, water is a biodermal constituent. The water used by Bernstein would be the same compound as water extracted from the skin. Therefore, water as used in Bernstein can be considered a biodermal constituent. Bernstein does teach using varying concentrations of water in the Examples. All of the example formulations use amounts of water around 50%. The appellant's claims state that water can be present in a "minor" amount. A "minor" amount is defined by the appellant as an amount less than 50% (see page 3 of response filed June 30, 2003). Thus, a "minor" amount of water can be anything less than 50% including 49.9% water. This small variation in the amount of water between the claimed invention and Bernstein's teachings very reasonably falls within routine experimental optimization. It would be common sense for an artisan to vary the amount of water used to dilute the concentrates of Bernstein. Varying the amount of water would be routine to change well known cosmetic parameters such as consistency, appearance, skin feel, smell, storage stability, etc. Varying consistency, appearance, skin feel, smell and storage stability are also part of design choice that an artisan would routinely carry out. The effects of varying the amount of water in the composition would

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have predictable effects on the cosmetic. Thus, it is considered an obvious modification of Bernstein to include water in amounts less than 50%.

In regards to the 103(a) rejection based on Bernstein in view of Yu, the appellant argues that Bernstein and Yu both teach “traditional” cosmetic products that have more excipient than the claimed invention. The appellant also argues that neither reference “recognizes the ‘by weight’ percentage of the biodermal and the non-biodermal constituents as result-effective variable.”

However, as discussed above, the claims of Bernstein are considered to teach a composition that anticipates the composition claimed by the appellant in claim 1. The claimed composition of Bernstein only contains biodermal ingredients and does not require an excipient. Bernstein teaches that the amount of each of the biodermal ingredient can be varied based on the weight of the ingredient in comparison to the weight of the total composition. Thus, Bernstein is acknowledging that the amount of the biodermal ingredients can be varied by weight. Therefore, the examiner does not agree with the appellant’s assertion that Bernstein does not teach that the weight of each biodermal ingredient is a result effective variable.

The appellant also argues that Yu does not teach that the weight concentrations are result-effective variables and that Yu does not teach a bio-dermal fraction. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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The appellant's claims specifically claim a non-biodermal ingredient as a trace element. Yu teaches a composition for treating dry skin that contains trace elements (see column 3, lines 39-46). Thus, Yu shows that it was well known in the art at the time of the invention that trace elements can be used in cosmetic compositions to treat dry skin. As discussed above, the composition of Bernstein is specifically claimed as treating dry skin. As discussed in MPEP 2144.06:

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.

Thus, it would have been obvious at the time of invention to include trace elements in the cosmetic composition taught by Bernstein because they were known to be useful in compositions that treat dry skin.

Furthermore, it is considered obvious to vary the amount of the trace elements for many of the same reasons that it is considered obvious to vary the amount of water in the composition. An artisan would reasonably expect that varying the amount of trace elements in the composition taught by Bernstein and Yu would be a means to design a composition with the most desirable characteristics. An artisan would expect that changing the amounts of trace elements would have a predictable effect on the appearance, smell, feel, and storage stability of the cosmetic. Thus, it is considered an obvious modification of the composition taught by Bernstein and Yu to vary the amount of trace elements in the composition.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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Primary Examiner, Art Unit 1655

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